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Docket No.: 1912-0303PUS1  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Louis-Philippe VEZINA

Application No.: 09/678,303

Confirmation No.:

Filed: October 3, 2000

Art Unit: 1638

For: PROMOTER FOR REGULATING  
EXPRESSION OF FOREIGN GENES

Examiner: G. Helmer

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED  
UNINTENTIONALLY UNDER 37 C.F.R. § 1.137(b)**

MS PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

August 26, 2005

Sir:

Applicants hereby Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 C.F.R. § 1.137(b).

**1. Previous Petition filed April 1, 2005**

On April 1, 2005, Applicants filed a Petition to Withdraw Holding of Abandonment under 37 C.F.R. 1.181, or alternatively a Petition for Revival of an Unintentionally Abandoned Application under 37 C.F.R. § 1.137(b). For convenience a copy of the Petition filed on April 1,

2005 is here included. The Petition to Withdraw Holding of Abandonment under 37 C.F.R. 1.181 was dismissed in the Petition Decision of July 26, 2005, however the alternative Petition under 37 C.F.R. § 1.137(b) on page 5 was not mentioned in the Decision.

Therefore, the Commissioner is respectfully requested to accept this Petition under 37 C.F.R. § 1.137(b) for revival of an Application for Patent Abandoned Unintentionally. The Petition fee of \$750.00 (37 C.F.R. § 1.17(m)) was included with the original Petition filed on April 1, 2005.

As stated in the Petition filed April 1, 2005, the present application was filed after May 29, 2000. Therefore, a terminal disclaimer should not be required as a condition of granting an untimely petition to withdraw the holding of abandonment, since patent term adjustment is automatically reduced under the provisions of 37 C.F.R. § 1.704(c)(4).

Statement: The entire delay in filing the instant petition under 37 C.F.R. § 1.181 to withdraw the holding of abandonment from two (2) months after the mail date of the notice of abandonment until the filing of a grantable petition under 37 C.F.R. § 1.181 was unintentional.

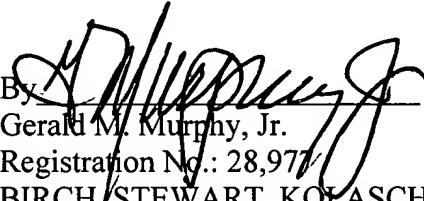
## **2. Conclusion**

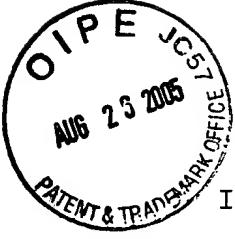
If the U.S. Patent Examiner has any questions regarding the above matters, please contact the undersigned at the phone number listed below.

However, if necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fee required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated:

Respectfully submitted,

By   
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MS PETITION  
PATENT  
1912-0303PUS1

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: VEZINA et al.

Conf.:

Appl. No.: 09/678,303

Art Unit: 1638

Filed: October 3, 2000

Examiner: G. Helmer

For: PROMOTER FOR REGULATING EXPRESSION OF  
FOREIGN GENES

PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. 1.181  
SINCE REPLY WAS TIMELY FILED OR ALTERNATIVELY PETITION  
FOR REVIVAL OF AN UNINTENTIONALLY ABANDONED APPLICATION

MS PETITION

April 1, 2005

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Notice of Abandonment mailed July 14, 2004, which issued in connection with the above-identified application, this is a Petition to withdraw the "abandonment status" of the present application, since a Reply was timely filed on January 14, 2004 or alternatively for revival of an unintentionally abandoned application.

1. EVIDENCE

The Examiner assigned to the present application issued a Final Office Action on June 3, 2003 setting a date for reply to expire three (3) months from the mailing date of the Office

Action (i.e., September 3, 2003). A copy of the Final Office Action is attached hereto.

Applicants responded with a timely filed Amendment on **September 24, 2003**, which included a proper petition for a one (1) month extension of time from September 3, 2003 to October 3, 2003. A copy of the Amendment is attached hereto.

The Examiner issued a Notice of Non-Responsive Amendment on **December 18, 2003**, a copy of which is attached hereto. The Notice indicated that the Amendment filed on October 23, 2003 was *bona fide*, but did not comply with revised 37 C.F.R. § 1.121. Most importantly, the Notice set a date of **one (1) month or thirty (30) days from the mailing date of the notice** in which to correct the non-compliant section(s) of the Amendment (i.e., **January 18, 2004**). The Notice further stated that extensions of this time period were available under 37 C.F.R. § 1.136(a).

In response to the Notice, Applicants filed via facsimile a compliant Amendment on **January 15, 2004**, which date is less than 1 month or 30 days from the mailing date of the Notice. A copy of the Amendment filed on January 15, 2004 is attached hereto. An automatically generated return receipt confirmation was received from the USPTO indicating that all five (5) pages of the Amendment were received by the USPTO on January 15, 2004. A copy of the return receipt confirmation is attached hereto.

The Examiner then issued a Notice of Abandonment erroneously dated "07/14/2002" on the cover sheet, and received by Applicants on July 22, 2004. A copy of the Notice of Abandonment is attached hereto. It is evident that the date on the cover sheet

is erroneous since paragraph 1(a) of the Notice states that a reply was received on January 15, 2004, therefore making it impossible for the Examiner to have mailed the Notice on the day before. Paragraph 1 also indicates that the Final Office Action was mailed on June 2, 2003, which is clearly erroneous (see, Final Office Action dated June 3, 2003 attached hereto).

In any event, paragraph 1(a) of the Notice indicates, "A reply was received on 15 January 2004..., which is after the expiration of the period for reply (including a total extension of time of 3 month(s)) which expired on 03 January 2004." Paragraph 7 indicates, "Applicant filed a responsive After Final Amendment on 15 January 2004, which is after the six-month time period following the mailing of the Final Rejection, which was mailed on 2 June 2003. This amendment was not entered."

The expiration of the period for reply set forth in the Notice of Abandonment is clearly erroneous. As noted above, the Notice of Non-Responsive Amendment set a date of **one (1) month or thirty (30) days from the mailing date of the notice** in which to respond. Specifically, the Notice of Non-Responsive set a date of **January 18, 2004** in which to respond. The six month date of January 3, 2004 relied upon by the Examiner is irrelevant since the filing of the Amendment on September 23, 2003 tolled the six month period.

Thus, contrary to the Examiner's remarks in the Notice of Abandonment, the expiration of the period for Reply was **January 18, 2004 rather than January 3, 2004**. Again, Applicants duly filed a compliant Amendment on **January 15, 2004**, receipt of which

was acknowledged by the USPTO. For these reasons, the Notice of Abandonment is improper and should be withdrawn.

Furthermore, a Notice of Appeal is filed concurrently with this petition under separate cover. This Notice of Appeal constitutes a full response to the Final Office Action dated June 3, 2003.

In summary, as evidence of the fact that a Reply was timely filed, enclosed herewith are the following documents:

- A copy of the Final Office Action dated June 3, 2003;
- A copy of an Amendment filed on September 24, 2003;
- A copy of the Notice of Non-Compliant Reply dated December 18, 2003;
- A copy of an Amendment filed on January 15, 2004;
- A copy of the automatically generated return receipt confirmation dated January 15, 2004; and
- A copy of the Notice of Abandonment dated July 14, 2004.

It is requested that the abandonment status of the present application be immediately removed so that prosecution may resume with full consideration and entry into the record of the timely filed Reply.

It is submitted that no fees are required for filing this Petition, since the error occurred because of a mistake on the part of the U.S. Patent and Trademark Office.

## **2. TERMINAL DISCLAIMER**

The present application was filed after May 29, 2000. Therefore, a terminal disclaimer should not be required as a

condition of granting an untimely petition to withdraw the holding of abandonment, since patent term adjustment is automatically reduced under the provisions of 37 C.F.R. § 1.704(c)(4).

**3. ALTERNATIVE PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. § 1.137(b)**

If this Petition under 37 C.F.R. § 1.181 to withdraw the holding of abandonment is dismissed as untimely under 37 C.F.R. § 1.181(f), then the Commissioner is respectfully requested to accept this Petition under 37 C.F.R. § 1.137(b) for revival of an application for patent abandoned unintentionally.

The Petition fee of fee \$750.00 (37 C.F.R. § 1.17(m)) is attached hereto. Applicant claims small entity status. See 37 C.F.R. § 1.27. As noted above, an Amendment was previously filed on January 15, 2004. Since this utility application was filed on or after May 29, 2000, no terminal disclaimer is required.

Statement: The entire delay in filing the instant petition under 37 C.F.R. § 1.181 to withdraw the holding of abandonment from two (2) months after the mail date of the notice of abandonment until the filing of a grantable petition under 37 C.F.R. § 1.181 was unintentional.

**4. CONCLUSION**

If the U.S. Patent Examiner has any questions regarding the above matters, please contact the undersigned at the phone number listed below.

However, if necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fee required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Gerald M. Murphy, Jr., #28,977

GMM/KLR Falls Church, VA 22040-0747  
1912-0303PUS1 (703) 205-8000

## Attachments:

1. Final Office Action (June 3, 2003);
2. Amendment (September 24, 2003);
3. Notice of Non-compliant Reply (December 18, 2003);
4. Amendment (January 15, 2004);
5. Return receipt confirmation (January 15, 2004); and
6. Notice of Abandonment (July 14, 2004)